REMARKS

In the Office Action[1] mailed May 2, 2008, the Examiner rejects claims 1-3, 7-13, 15-22, 26-32, and 34-39 under 35 U.S.C. § 102(b) as being anticipated by *Todd* (U.S. Patent Application Publication 2003/0061093);[2] rejects claims 4-6, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of *Atkins* (U.S. Patent No. 5,644,727); and rejects claim 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view Examiner's Official Notice.

By this Amendment, Applicant amends claims 1, 13, 15, 21, 32, 38, and 39, cancels claims 12 and 31 without prejudice or disclaimer, and adds new claim 40. Thus, claims 1-11, 13-30, and 32-40 are pending and under current examination.

I. The rejection under 35 U.S.C. § 102(b)

Applicant respectfully traverse the rejection of claims 1-3, 7-13, 15-20, 38 and 39 under 35 U.S.C. § 102(e) as anticipated by *Todd*. In order to properly establish that *Todd* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

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[1] The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

[2] The listing of claims rejected in Item 13 of the Office Action does not correspond to all of the claims addressed under item 13. Applicant understands this to be a clerical error and thus assumes the Examiner intends to reject the claims under 35 U.S.C. § 102 as identified under item 13.

Todd does not disclose each and every element of Applicant's claimed invention. Instead, *Todd* discloses a system "for rewarding users of financial services in a manner that promotes savings without requiring a financial services provider to administer multiple individual investment accounts." ¶ 11. The system may reward users of financial services based on transactions completed through a financial services provider through "a means for one user of the services to transfer value for the direct benefit of another one of the users." ¶ 12. Indeed, *Todd* explains that it provides

> a process and system for "rewarding customers of a financial services provider based on transactions completed using services of the financial services provider. Value is accumulated on behalf of each user, without requiring the financial services provider to manage multiple separate investment accounts. Through transfer requests, each customer is able to use all or a portion of the accumulated value in an account **for the benefit of another customer**.

¶ 33 (emphasis added). On the other hand, claim 1 recites, *inter alia,*

> monitoring, by a computer system associated with one of the financial account providers, transactions performed using the first and second financial accounts over a predetermined transaction monitoring period;
>
> determining, by the computer system, whether any of the monitored transactions meet at least one predetermined condition;
>
> determining, by the computer system, whether any transactions that meet the predetermined condition are associated with the second financial account;
>
> automatically transferring, by the computer system, any transactions associated with the second financial account that meet the predetermined condition to the first financial account; and
>
> applying, by the computer system, an incentive to the first financial account based on the predetermined condition.

The Examiner asserts *Todd* discloses the monitoring, determining, and applying features of claim 1 in at least paragraphs 32, 45, and 73. *See* OA at 2 and 4. Moreover, the Examiner asserts *Todd* discloses determining whether any transactions that meet the predetermined condition are associated with the second financial account and transferring any transactions associated with the second financial account that meet the predetermined condition to the first financial account. *Id.* However, none of these cited paragraphs in *Todd*, nor any other paragraphs, disclose the above noted features of claim 1.

For instance, *Todd* explains in paragraph 45 the process of rewarding users "by incrementally adding value to each account each time a user, i.e., a customer of the financial institution, uses the financial services to complete an approved transaction." This passage merely explains how *Todd* may reward value to a user's account for transactions that take place using that "associated" account. Moreover, paragraph 73 merely describes alternative ways *Todd* may determine the amount of a reward and does not disclose monitoring transactions over two accounts held by the same user from two separate financial account providers, much less doing so via the same computer system. And while *Todd* describes a mechanism for allowing one user to transfer reward value to another user's account (*see e.g.,* ¶ 12, cited by the Examiner), this process does not teach or suggest "determining, by the computer system, whether any transactions that meet the predetermined condition are associated with the second financial account" and "automatically transferring, by the computer system, any transactions associated with the second financial account that meet the predetermined condition to the first financial account," as recited in claim 1.

Instead, *Todd* describes "a system 16 for monitoring transactions completed by users of a financial services provider . . . . Along with tracking the transactions, the system is configured to reward users . . . ." ¶ 45. In particular, *Todd* discloses "a means for **one user** of the services to transfer value for **the direct benefit of another one of the users**," (*Todd* ¶ 12, emphasis added), and does so via a transfer request provided by transferor. (*Todd*, ¶ 67). *Todd* also discloses "monitoring **reward** transfer information...." (*Todd* ¶ 20, emphasis added). *Todd* does not, however, disclose transferring transactions to another financial account, much less doing so when any transactions that meet a predetermined condition are associated with a second financial account, as recited in claim 1. Moreover, any transfers of rewards that takes place in *Todd*, does so at the request of a transferor, and only results in reward values being moved from one account to another. *See e.g., Todd*, ¶ 67. Indeed, *Todd* does not disclose automatically transferring transactions, as recited in claim 1.

Accordingly, because *Todd* does not disclose every recitation of claim 1, the reference does not support the rejection under 35 U.S.C. § 102(b). Therefore, Applicant respectfully requests that the rejection of claim 1 be withdrawn, and the claim allowed.

Independent claims 21, 38, and 39 include recitations similar to those of claim 1 addressed above. As explained, *Todd* fails to anticipate the recitations of claim 1. Therefore, for at least the same reasons set forth above in connection with claim 1, the rejection of claims 21, 38, and 39 is legally deficient, should be withdrawn, and the claims allowed.

Claims 2, 3, 7-11, 13, and 15-20 depend from claim 1. Claims 22, 26-30, 32, and 34-37 depend from claim 21. As explained, *Todd* fails to anticipate the recitations of

claims 1 and 21. Therefore, for at least the same reasons set forth above in connection with claims 1 and 21, the rejection of claims 2,3, 7-11, 13, and 15-20, 22, 26-30, 32, and 34-37 is legally deficient, should be withdrawn, and the claims allowed.

Further, *Todd* does not teach the additional recitations of these dependent claims. For instance, the Examiner asserts *Todd* discloses an incentive report, as recited in claims 36 and 37. *See* OA at 5. In contrast, however, *Todd* actually describes account records that are accessible to authorized users. *See* paragraph 53, cited by the Examiner. Nowhere does the reference disclose or even suggest providing an incentive report that includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined condition, as recited in claims 36 and 37. Consequently, the rejection of these claims should be withdrawn and the claims allowed.

Moreover, the rejection under 35 U.S.C. § 102(b) is legally deficient because the Examiner did not address every recitation of some of the dependent claims. For example, in rejecting claim 19, the Examiner asserts *Todd* discloses "applying [a] variety of incentives based on different category (sic) of transactions." *See* OA at 4. This position, however, does not address or contemplate, nor do paragraphs 25-27 of *Todd* cited by the Examiner teach or suggest,

> ranking the transactions based on a transaction parameter associated with each transaction;
>
> identifying a set of the transactions that each have a transaction parameter that meets or exceeds a predetermined transaction parameter threshold; and
>
> determining whether the set of transactions meet the at least one predetermined condition,

as recited in dependent claim 19.

37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2). In this case, not only is the reference asserted by the Examiner describe many different embodiments, the Examiner improperly ignores some recitations of the claims As such, the Examiner's rejection of at least claim 19 under 35 U.S.C. § 102(b) does not meet the requirements of 37 C.F.R. § 1.104, and thus is improper.

Accordingly, for these additional reasons, the rejection of claims 2,3, 7-11, 13, and 15-20, 22, 26-30, 32, and 34-37 is legally deficient, should be withdrawn, and the claims allowed.

II. The rejection of claims under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 4-6, and 23-25 as being unpatentable over *Todd* in view of *Atkins*. A *prima facie* case of obviousness has not been established because the cited art does not disclose or suggest the recitations of these claims, much less support a reasonable basis for suggesting the recitations would have been obvious.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007).* "A conclusion of

obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145.* Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III)*, internal citation omitted. In addition, when "determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

Claims 4-6 and 23-25 respectively depend from independent claims 1 and 21. As explained, *Todd* fails to anticipate the recitations of claims 1 and 21. Therefore, for at least the same reasons set forth above in connection with claims 1 and 21, the rejection of claims 4-6 and 23-25 is legally deficient, should be withdrawn, and the claims allowed. Moreover, *Atkins* fails to cure the aforementioned deficiencies of *Todd*. For example, *Atkins* does not teach or suggest, and the Examiner does not rely on *Atkins* to teach or suggest, at least,

> determining, by the computer system, whether any transactions that meet the predetermined condition are associated with the second financial account;
>
> automatically transferring, by the computer system, any transactions associated with the second financial account that meet the predetermined condition to the first financial account; and
>
> applying, by the computer system, an incentive to the first financial account based on the predetermined condition,

as recited in claim 1.

Therefore, the Examiner the rejection of claims 4-6, and 23-25 under 35 U.S.C. § 103(a) is not supported by *Todd* and *Atkins*. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 4-6, and 23-25 and allow the claims.

Similarly, Applicant further traverses the rejection of claims 14 and 33 as being unpatentable over *Todd* in view of the Examiner's Official Notice. Claims 14 and 33 respectively depend from independent claims 1 and 21, and, accordingly, incorporate each and every element recited in claims 1 and 21. As discussed above, *Todd* fails to teach or suggest the elements recited in claims 1 and 21 and required by claims 14 and 33. The Examiner's asserted Official Notice fails to cure the deficiencies of *Todd*.[3]

Further, Applicant traverses the Examiner's Official Notice because the Notice does not teach that which the Examiner admits is missing from *Todd*. Instead, the Examiner relies on an unsupported position that it was well known for "consumers" to "approve any financial transaction before it takes place." Yet, this position does not demonstrate "the user giv[ing] authorization to the first financial account provider to transfer the second financial account transactions to the first financial account[,]" as recited in claims 14 and 33 and missing from *Todd*. This is improper.

Therefore, a *prima facie* case of the obviousness of claims 14 and 33 has not been established over *Todd* and the Examiner's Official Notice. Accordingly, Applicant

[3] In the Office Action, the Examiner asserts that "Applicant did not properly traverse OFFICIAL NOTICE, therefore it is accepted as prior art." (Office Action, page 2). Applicant does not agree and indeed, points out that in the previous response by Applicant filed on February 22, 2008, Applicant did traverse the Examiner's previous assertion of OFFICIAL NOTICE. *See* page 16 of 2/22/08 Response.

respectfully requests that the Examiner withdraw the rejection of claims 14 and 33 and allow the claims.

III. New claim 40

The cited art also fails to disclose the recitations of claim 40, which includes, *inter alia*,

> receiving a forecast goal from the user reflecting an estimated transaction amount the user intends to perform using the first financial account over a future transaction monitoring period;
>
> determining whether the transactions includes purchase amounts associated with the first financial account that collectively meet the forecast goal;
>
> applying an incentive to the first financial account when the forecast goal is met; and
>
> providing an incentive report to the user based on the applied incentive,
>
> wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined condition.

For example, *Todd* or *Atkins*, alone or in combination, fail to teach or suggest a forecast goal, as recited in claim 40, much less applying an incentive to a financial account when the forecast goal is met. Accordingly, Applicant requests the timely allowance of claim 40.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of pending claims 1-11, 13-30, and 32-40.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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